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CENTRAL FAX CENTER****JAN 25 2007**Appl. No. 10/822294
Amdt. Dated 1-25-07
Reply to Office Action of 10-25-06**Remarks/Arguments**

Applicant would like to thank the examiner for the thorough review of the present application. Claims 1 through 7 have been canceled. Claim 8 has been amended to more narrowly claimed the present invention over the prior art of record.

In general, applicant objects to the examiner's method of rejecting the claimed recitations of the present invention. It appears the examiner has vaguely interpreted applicant's claimed recitations without giving patentable weight to specific structural elements recited in the claims. Such a vague and general interpretation of applicant's claim language is improper per the teachings of the MPEP. All the detailed and limiting terms of applicant's claim recitations must be examined and identified, or otherwise accounted for, in the prior art of record. Applicant requests the examiner to point out with reasonable clarity each and every claimed recitation made by the applicant. Otherwise, applicant can not provide a meaningful or accurate rebuttal to the examiner's reasoning for purposes of appeal. Applicant suggests the examiner to write applicant's claim language verbatim and identify each claimed element with a reference numeral or other reasonable identification marker so applicant can understand how the examiner has reached his conclusion, especially in light of the foreign patent reference which does not have a complete English translation on record. Clarification is requested.

Claim 8 is Patentable

Applicant's claimed recitations are critical and inherently necessary for allowing applicant's claimed invention to perform its intended function of detecting when a baseball has passed through the conduit so that the user can receive a monetary payment therefore. Lopez necessarily cannot employ all of applicant's claimed recitations because Lopez's intended function is to provide an insulated vending machine that defines an isolated system, which is not accessible from the exterior thereof unless a user deposits money into the machine (see Lopez's abstract and FIGS.). Therefore, it would be counter intuitive and one skilled in the art would not look to the prior art of record to combine with Lopez to build applicant's claimed invention because applicant's claimed structure and use of its elements are readily removable

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and susceptible to vandalism. One skilled in the art understands the Lopez's intended function would be defeated because unauthorized users would destroy its vending machine if it were constructed in the manner claimed by the applicant.

- *an automated coin dispensing system connected to said tube adjacent said top opening thereof, said coin dispensing system causing a predetermined amount of money to be ejected therefrom when a ball is passed downwardly through said tube and beyond the aperture.* One skilled in the art understands that Lopez's intended function is to receive coins and not dispense coins. It appears that Lopez's intended function is opposite to applicant's intended function and, therefore, not motivation is presented for employing applicant's claimed coin dispensing system.

- *said coin dispensing system including
 - a housing having a side wall connected to said tube and spaced between said plurality of brackets,
 - a reservoir disposed within said housing and containing a predetermined amount of money,
 - a sensor disposed within said housing and being aligned with the aperture so that said system will detect a ball traveling through said tube,
 - a solenoid connected to said sensor and being operably controlled thereby,
 - a power supply source connected to said sensor and for causing said solenoid to selectively receive a current therethrough and selectively operate said reservoir, and
 - a receptacle connected to said housing and being disposed therebeneath, said receptacle cooperating with said reservoir so that a user can readily retrieve money therefrom.* The examiner has failed to identify such claimed recitations

made by the applicant. Such recitations are critical and inherently necessary for housing applicant's sensor to be coupled to the tube in a manner that permits the user to readily retrieve money from the dispenser while maintaining the housing of the sensor connected to a side wall of the tube.

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Should the examiner find applicant's arguments unpersuasive, applicant respectfully submits the following newly claimed recitations clearly place the present invention in condition for allowance.

Applicant has amended the claims to more narrowly distinguish the present invention over the prior art of record. Applicant respectfully submits no new matter has been introduced, which would affect the statutory requirements of patentability, because all newly claimed recitations are clearly supported by the original drawings. A person of ordinary skill in the art is enabled to make and use the presently claimed invention based on the originally filed drawings. Applicant has included case law, wherein the Court has held the claims may be amended based upon the originally filed drawings without triggering a new matter rejection (please see attached literature).

Applicant claims:

- *a hollow tube having top and bottom openings defining a conduit therebetween and for receiving and dispensing a ball respectively, said tube having an aperture formed ~~therein~~ through a sidewall thereof, said aperture being spaced beneath said top opening and above said bottom opening and adjacent said top opening thereof, wherein said top and bottom openings face along respective first and second orthogonally registered planes.* Lopez's upper and lower portions necessarily define openings along parallel planes for receiving and discharging balls at vertical positions (see FIG. 1). Further, no aperture is taught by Lopez, in the manner claimed by the applicant, nor is there any motivation for providing applicant's claimed aperture to Lopez.
- *said tube including
 - an elongated uppermost portion disposed substantially vertically and rearward of a support surface, said aperture being formed within said upper portion, and*
 - an arcuate lowermost portion integral with said upper portion, said lower portion extending outwardly and substantially perpendicularly from said upper portion to thereby become disposed forward of a support surface so that a ball**

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may be directed therethrough and towards a playing surface. Lopez's uppermost and lowermost tube portions are not positioned rearward and forward of a support surface, as claimed by the applicant. Rather, such portions are necessarily housed within a support surface (vending machine) for keeping the balls safe from unauthorized access (see FIG. 1).

- *a plurality of flexible mounting brackets adjustably engageable about said tube, said plurality of mounting brackets being spaced apart from each other and ~~connectable~~ connected to a support surface so that said device can be selectively positioned at a predetermined location along a support surface, said mounting brackets extending about an entire circumference of said tube;* Threadgill fails to teach the position of applicant's claimed mounting brackets about the circumference of its tube. Furthermore, Lopez has no need for applicant's claimed mounting brackets because it is housed within a vending machine housing.

In view of these considerations, it is respectfully submitted that the rejection of the pending claims should be considered as no longer tenable with respect to the above mentioned arguments and claim amendments. All pending dependent claims necessarily include the recitations of their independent claims and therefore are also in condition for allowance.

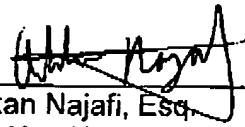
Should the examiner consider necessary or desirable to make formal changes anywhere in the specification, claims and/or drawings, then it is respectfully asked that such changes be made by examiner's Amendment, if the examiner feels this would facilitate passage of the case to issuance. Alternatively, should the examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned attorney.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

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Respectfully submitted,
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for later submitted claims does not warrant employment of §132 as a basis for rejection of later submitted claims on the ground that the latter are adding new matter to the original claim portion of the disclosure. To so hold would render §132 redundant in light of §112, first paragraph.⁴⁹²

The CCPA remarked that the originally filed specification described the step of applying the adhesive as follows: "[A]dhesive is applied to the tubular foil 4 in a narrow or broader strip, possibly in two narrow strips. Accordingly, the face of the tubular foil successively sticks to the winding lying on the drums."⁴⁹³ The specification thus described one method of adheringly applying the various layers in the thermal insulation. On the basis of this description, the CCPA held that "one skilled in the art who read Rasmussen's specification would understand that it is unimportant *how* the layers are adhered, so long as they are adhered. Thus the phrase 'adheringly applying' is supported by the example found in the specification."⁴⁹⁴

Rasmussen therefore teaches that an original claim and examples in the specification may be used to support amendments after the application is filed.

C. Drawings That Provide Support for Amendments to Specification

Drawings may provide an adequate written description of the invention in the event the written disclosure portion of the application inadvertently omitted such a written description. *In re Wolfensperger*⁴⁹⁵ is an example of when the original drawings were used to provide, in part, the written description of the invention under Section 112, first paragraph. In *Wolfensperger*, the invention related to a ball-type valve used in high-pressure fluid pipelines. The valve contained a shut-off member constructed of a spherical ball plug. The Examiner and the Board rejected a specific claim of the patent application on the grounds that the claim was not adequately described in the specification. In particular, the claim recited a two-dimensional relationship including a "packing ring" in "untensioned condition" that included "a mean diameter corresponding approximately to the mean diameter of said chamber."⁴⁹⁶

On appeal, the CCPA reversed. The court disagreed with the Board's statement that it was well-established legal precedent that

⁴⁹²*Id.*, 211 USPQ at 326 n.5 (citing *In re Anderson*, 471 F.2d 1237, 1238, 176 USPQ 331, 832 (C.C.P.A. 1973)).

⁴⁹³*Id.*, 211 USPQ at 326.

⁴⁹⁴*Id.*, 211 USPQ at 327 (footnote omitted) (emphasis in original).

⁴⁹⁵*In re Wolfensperger*, 302 F.2d 950, 133 USPQ 537 (C.C.P.A. 1962).

⁴⁹⁶*Id.*, 133 USPQ at 538.

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drawings alone cannot constitute a written description of the invention. The CCPA stated as follows in this connection:

Consider, for one thing, that the sole disclosure in a design patent application is by means of a drawing. Rule 153. For another thing, consider that the only informative and significant disclosure in many electrical and chemical patents is by means of circuit diagrams or graphic formulae, constituting "drawings" in the case.⁴⁹⁷

The CCPA then described the general test for determining whether a drawing can constitute an adequate written description of the invention under Section 112, first paragraph:

The practical, legitimate enquiry in each case of this kind is what the drawing in fact discloses to one skilled in the art. Whatever it does disclose may be added to the specification in words without violation of the statute and rule which prohibit "new matter," 35 U.S.C. 132, Rule 118, for the simple reason *that* what is originally disclosed cannot be "new matter" within the meaning of this law. If the drawing, then, contains the necessary disclosure, it *can* "form the basis of a valid claim."⁴⁹⁸

The CCPA held that figure 5 of the application clearly showed that the ring had a mean diameter corresponding approximately to the mean diameter of an annular chamber.⁴⁹⁹ On this basis, the court held that the application satisfied the written description requirement. Thus, *Wolfensperger* teaches that drawings may provide the basis for subsequent amendments to the specification without producing prohibitory new matter therein.

D. New Matter and Correcting Obvious Errors

An applicant may generally correct obvious errors in the application without introducing prohibitory new matter. For example, translation errors from foreign prior applications may generally be corrected.⁵⁰⁰ The general rule is that if the error can be detected and corrected by one of ordinary skill in the art, then the applicant may amend the application to correct the error without introducing new matter.⁵⁰¹

*Ex parte Brodbeck*⁵⁰² is an example of when an applicant was permitted to amend the specification to correct an obvious error. In *Brodbeck*, the invention related to a process of catalytic isomerization of a compound. Brodbeck sought to reissue his already-granted patent, U.S. Patent Number 3,647,898, by amending the claim portion of the application. The original claim 1 of the issued patent recited the lim-

⁴⁹⁷*Id.*, 133 USPQ at 541-42.

⁴⁹⁸*Id.*, 133 USPQ at 542 (emphasis in original).

⁴⁹⁹*Id.*, 133 USPQ at 541.

⁵⁰⁰*See In re Oda*, 443 F.2d 1200, 170 USPQ 268, 272 (C.C.P.A. 1971).

⁵⁰¹*Id.*

⁵⁰²*Ex parte Brodbeck*, 199 USPQ 230 (Pat. Off. Bd. App. 1977).

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